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EXAMINER

EDWIN M. SZALA  
NATIONAL STARCH AND CHEMICAL CO.  
BOX 6500  
BRIDGEWATER, NJ 08807

13M1

GOLIAN, J

ART UNIT

PAPER NUMBER

1302

DATE MAILED:

04/20/93

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined

Responsive to communication filed on

01-21-92

This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

**Part II SUMMARY OF ACTION**

1.  Claims 29-42 are pending in the application.

Of the above, claims 36-42 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 29-35 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received

been filed in parent application, serial no. \_\_\_\_\_ filed on \_\_\_\_\_

Applicant's election with traverse of claims 29-35 in Paper No. 23 is acknowledged. The traversal is on the ground(s) of a bare traversal with no specific reasons set forth. This is not found persuasive because of the specific reasons set forth in the restriction requirement set forth in the last office action.

The requirement is still deemed proper and is therefore made FINAL.

Claims 36-42 stand withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 23.

This application contains claims 36-42 drawn to an invention non-elected with traverse in Paper No. 23. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

Note the attached PTO-1449. A reference was canceled from Applicants' form since a copy of the reference was not furnished.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of

this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 29-35 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Tomita et al for the reasons of record. The amendments to the claims are not seen to influence the conclusions of unpatentability previously set forth.

The Rule 131 declaration neither establishes a generic invention nor discloses all the members of the Markush grouping, specifically that taught by Tomita et al.

Claims 29-35 are rejected under 35 U.S.C. § 103 as being unpatentable over Hill in view of the admitted state of the art (Barnett et al) for the reasons of record. The new limitations to the claims are not seen to influence the conclusion of unpatentability previously set forth. The new limitations are considered, at best, control limitations well within the determination of one with the ordinary skill in the art.

Applicant's arguments filed October 19, 1992 have been fully considered but they are not deemed to be persuasive.

Applicants acknowledge that Hill discloses food utility but dismisses the pertinency since they state that the ingredients used for hydrolyzing are not approved for food use. It is not seen what pertinent bearing this has on the rejection. The Hill reference in fact discloses food utility which is exactly that which is claimed.

Applicant further arguments directed to Barnett et al are not considered particularly germane. The rejection is not on Barnett et al per se but on a combination of the reference teachings. Arguments which do not address the rejection as applied are not pertinent. It is again pointed out that Barnett et al teach depolymerization to the extent claimed and to depolymerize the products of Hill to the extent of Barnett et al would have only involved only the ordinary skill of one in the art.

All of Applicants' arguments have been considered. None of them are convincing of patentability.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Joseph Golian at telephone number (703) 308-3851.

Joseph M. Golian  
April 19, 1993

Joseph M. Golian  
PRIMARY EXAMINER  
ART UNIT 1302